Remarks

This paper is in response to the Office Action mailed October 27, 2003 in connection with the above-identified patent application. In that Action, claims 1-28 were rejected under 35 U.S.C. § 102(f). Also, the Action was made final.

The Rejections Under 35 U.S.C. § 102(f) are Improper:

As noted above, claims 1-28 were rejected under 35 U.S.C. § 102(f) because, according to the Examiner, the applicant did not invent the claimed subject matter, which, according to the Examiner, is anticipated by U.S. Patent No. 6,493,720 to Chu, et al. It is respectfully submitted that this rejection is improper and should be withdrawn.

First, according to M.P.E.P. § 706.02(g):

> 35 U.S.C. 102(f) bars the issuance of a patent where an applicant did not invent the subject being claimed and sought to be patented. See also 35 U.S.C. 101, which requires that whoever invents or discovers is the party who may obtain a patent for the particular invention or discovery. The Examiner must presume the applicants are the proper inventors unless there is proof that another made the invention and that applicant derived the invention from the true inventor. (emphasis added)

In the application at hand, it is to be noted that each of the present application and the Chu, et al. '720 patent include cross-reference to each other as being co-pending and commonly assigned. More particularly, the Examiner's attention is directed to page 1 of the specification in the subject application beginning at line 11. In the Chu, et al. '720 patent, the instant application is referenced at column 1, beginning at line 16.

Since the Chu, et al. '720 patent and the instant application are mutually cross referenced, and commonly assigned, it would be a natural consequence then if there were some similarity in subject matter or overlap in

inventive entity. Indeed, the inventors identified on the Chu, et al. '720 patent include Jing Huang Chu and Jacques Joseph Labrie. In the present application, the sole inventor identified in the application materials includes Jacques Joseph Labrie.

Basically, therefore, the inventive entity in the Chu, et al. '720 patent was Chu and Labrie. The inventive entity in the instant application is Labrie.

Applicant believes the rejection under 35 U.S.C. § 102(f) is improper because the Examiner must presume the applicants are the proper inventors unless there is proof that another made the invention and that the applicant derived the invention from the true inventor. In the case at hand, Mr. Jacques Joseph Labrie formed part of the inventive entity in both the Chu, et al. '720 patent as well as in the instant application. If, at the time the instant application was filed, it was believed that Jing Huang Chu contributed to the claimed subject matter for purposes of an inventorship determination, Jing Huang Chu would have simply been added to the declaration form and would have reviewed and approved the final draft of the instant application before filing. That did not happen, and accordingly, it is to be assumed that Jacques Joseph Labrie is the sole inventor of the subject matter claimed in the instant application.

Again, according to M.P.E.P. § 706.02(g) the Examiner must presume the applicants are the proper inventors unless 1) there is proof that another made the invention and 2) that applicant derived the invention from the true inventor. The Examiner has not demonstrated any proof that another made the invention nor has she demonstrated any proof that the applicant derived the invention from the true inventor. As to the first point above, applicant will not burden the record with a rigorous analysis of the Chu, et al. '720 patent in part because that patent and the instant application are commonly assigned. However, the Examiner has not met the burden of proof by showing that another made the invention. At column 2, beginning at line 4 of the Chu, et al. '720 patent, data stored on a data storage device connected to a computer is synchronized. At specific intervals, a tool that operates on an object is monitored to identify changes to metadata of that object. When changes to the metadata are identified, an information catalog containing corresponding metadata for the object is

updated. On the other hand, in the present application, and as described on page 2, beginning at line 26 of the specification, data stored on a data storage device connected to a computer is navigated. In response to receiving user input, a target object in an information catalog is selected. Then, information about a source from which the target object was derived is provided. Again, the Examiner has not met her proof to rebut the presumption that applicant is the proper inventor.

As to the second point above, the Examiner has not met her burden of proof by showing that the applicant derived the invention from the true inventor. It is hard for applicant Jacques Joseph Labrie to imagine how he could have derived the invention from the authors of the Chu, et al. '720 patent, namely Jing Huang Chu and himself.

The Finality of the Office Action is Improper:

It is respectfully submitted that the designation of the previous Office Action as "final" was improper. More particularly, the Examiner stated in the record that "applicant's amendment necessitated the new ground(s) of rejection." However, this is not the case. In particular, attention is invited to claim 7 wherein applicant made some minor amendments including adding "data" to reinforce that information is provided about source data from which the target object was derived. In addition, the words "contents of" was deleted from the claim to reinforce that the transformation is performed on the source data rather than the contents of the source data.

Turning now to the Examiner's rejection of claim 7 at the top of page 3 of the previous Office Action, the Examiner is now attempting to apply the Chu, et al. '720 patent against the pending claims but failed to take into consideration the amendments tendered to claim 7. More particularly, the Examiner alleges that Chu shows one or more computer programs performed by the computer, for selecting a target object in an information catalog and providing information about a source from which the target object was derived. Claim 7 was amended before the previous Office Action to recite one or more computer programs, performed by the computer, for, in response to receiving user input, selecting a target object in

an information catalog and providing information about source data from which the target object was derived via a transformation performed on ~~contents of~~ said source data.

Clearly, applicant's amendment did not necessitate new grounds of rejection. Accordingly, it is respectfully requested that the finality of the previous Office Action be withdrawn.

Conclusion

Applicant respectfully submits that all pending claims are patentably distinct and unobvious over the art of record.

It is respectfully requested that, in the event this amendment does not place the application in condition for allowance, the Examiner contact applicant's representative identified below to arrange a telephonic Examiner's Interview to advance prosecution.

Allowance of all pending claims and early notice to that effect is respectfully requested.

Respectfully submitted,

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